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10/680,012	10/07/2003	Michael Furst	FURST, M-1	4718

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WILLIAM COLLARD
COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/680,012	Applicant(s) FURST, MICHAEL	
	Examiner Catherine Simone	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 June 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,7 and 9-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,7 and 9-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 102 rejection of claims 1-7, 9-14, and 22-30 as being anticipated by Rowe of record in the last Office Action mailed 3/15/05, Pages 2-3, Paragraph #2 has been withdrawn due to the Applicant's amendment filed 6/10/05.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 7 and 9-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation "said film layers are produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET), or polyacrylonitrile" in claim 1 is deemed new matter. The specification, as originally filed, does not provide support for the invention as is now claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 2, 9-11, 22, 23 and 27-30** are rejected under 35 U.S.C. 102(b) as being anticipated by Stierli (US 4,442,148).

Stierli discloses a film-bitumen combination comprising at least three layers (Figure 1) wherein the at least three layers comprise at least two film layers made from different materials (Fig. 1, #2 and #3) and the film layers are produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET) or polyacrylonitrile (see col. 3, lines 66-68 and col. 4, line 11). Regarding claim 2, at least two film layers inherently have different coefficients of thermal expansion since they are both made from different materials (see col. 3, lines 66-67 and col. 4, lines 10-15). Regarding claim 9, note at least two film layers (Fig. 1, #2 and #3) are laminated to a bituminous layer (Fig. 1, #1) individually or together. Regarding claim 10, note the bituminous layer is coated on the at least two film layers (see col. 4, lines 52-55). Regarding claim 11, note at least one film layer (Fig. 1, #2) facing the bituminous layer provides a mineral oil barrier (see col. 4, lines 6-9). Regarding claim 22, each individual film layer is arranged in the combination in accordance with its thermal stability (see col. 4, line 65 to col. 5, line 6). Regarding claim 23, each individual film layer is arranged in the combination according to its mechanical strength (see col. 5, lines 1-6). Regarding claim 27, note at least two film layers comprise a first film layer (Fig. 1, #3) and a second film layer (Fig. 1, #2), the first film layer

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(Fig. 1, #3) being located further away from the bituminous layer (Fig. 1, #1) and inherently having a larger coefficient of elongation than the second film layer since both films are made from different materials (see col. 3, lines 66-67 and col. 4, lines 10-15). Regarding claim 28, the bituminous layer (Fig. 1, #1) has a surface facing away from the at least two film layers (Fig. 1, #2 and #3) and a release liner is provided on the surface (Fig. 1, #4; also see col. 4, lines 28-31). Regarding claims 29 and 30, the release liner comprises release paper coated with silicone (see col. 4, lines 28-31).

6. **Claims 1, 2, 7, 9-11 and 22-27** are rejected under 35 U.S.C. 102(b) as being anticipated by Jenkins et al. (US 5,824,401).

Jenkins et al. discloses a film-bitumen combination comprising at least three layers (Figure 1) wherein the at least three layers comprise at least two film layers made from different materials (Fig. 1, #18 and #20) and the film layers are produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET) or polyacrylonitrile (see col. 4, lines 8-10 and lines 62-64). Regarding claim 2, the at least two film layers inherently have different coefficients of thermal expansion since both are made from different materials (see col. 4, lines 8-10 and 62-65). Regarding claim 7, at least one of the at least two film layers is produced from polyethylene terephthalate and is oriented (see col. 4, lines 63-64). Regarding claim 9, the at least two film layers (Fig. 1, #18 and #20) are laminated to a bituminous layer (Fig. 1, #12) individually or together (see col. 3, lines 25-30). Regarding claim 10, the bituminous layer (Fig. 1, #12) is coated on the at least two film layers (see col. 6, lines 10-12). Regarding claim 11, at least one film layer (Fig. 1, #20) facing the bituminous layer provides a mineral oil barrier (see col. 4, lines 58-61). Regarding claim 22, each individual film layer is arranged in the

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combination in accordance with its thermal stability (see col. 5, lines 20-27). Regarding claim 23, each individual film layer is arranged in the combination according to its mechanical strength (see col. 5, lines 20-27). Regarding claim 24, note a tie layer or an adhesive disposed between two adjacent layers of the at least two film layers (see col. 5, lines 39-42). Regarding claim 25, note further a barrier layer against mineral oils, oxygen or UV radiation disposed between two adjacent layers of the at least two film layers (see col. 4, lines 47-56). Regarding claim 26, the barrier layer comprises a layer of lacquer (see col. 4, lines 62-66). Regarding claim 27, note at least two film layers comprise a first film layer (Fig. 1, #18) and a second film layer (Fig. 1, #20), the first film layer (Fig. 1, #18) being located further away from the bituminous layer (Fig. 1, #12) and inherently having a larger coefficient of elongation than the second film layer since both films are made from different materials (see col. 4, lines 8-10 and col. 4, lines 62-65).

7. **Claims 1, 2, 7, 9-11, 15, 16, 18 and 20-30** are rejected under 35 U.S.C. 102(b) as being anticipated by Wiercinski et al. (US 5,687,517).

Wiercinski et al. discloses a film-bitumen combination comprising at least three layers (Figure 2) wherein the at least three layers comprise at least two film layers made from different materials (Fig. 2, #22 and #22A and see col. 6, lines 58-64) and the film layers are produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET) or polyacrylonitrile (see col. 4, lines 31-36 and col. 6, lines 7-10 and lines 62-64). Regarding claim 2, the at least two film layers inherently have different coefficients of thermal expansion since both are made up of different materials (see col. 3, lines 49-53 and col. 6, lines 61-64). Regarding claim 7, the PET layer is oriented (see col. 4, lines 62-63). Regarding claim 9, the at least two film layers (Fig. 2, #22 and #22A) are laminated to a bituminous layer (Fig. 2, #12)

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individually or together. Regarding claim 10, the bituminous layer (Fig. 2, #12; see col. 5, lines 58-60) is coated on the at least two film layers (Fig. 2, #22 and #22A). Regarding claim 11, note at least one film layer facing the bituminous layer provides a mineral oil barrier (see col. 6, lines 59-64). Regarding claim 15, a surface of a side of the combination facing away from the bituminous layer has been treated to have non-slip properties (see col. 4, lines 1-16). Regarding claim 16, the non-slip treatment is carried out by means of coating (see col. 6, lines 46-50). Regarding claim 18, the non-slip treatment is carried out by means of at least partial embossing of the surface (see col. 3, lines 62-65). Regarding claim 20, the non-slip treatment is provided by a coextruded syndiotactic polystyrene film (see col. 4, line 37). Regarding claim 21, the non-slip treatment is provided by a thermoplastic elastomer with a metallocene complex (see col. 4, line 37 and col. 6, lines 50-57). Regarding claim 22, each individual film layer is arranged in the combination in accordance with its thermal stability (see col. 5, lines 14-17). Regarding claim 23, each individual film layer is arranged in the combination according to its mechanical strength (see col. 5, lines 14-17). Regarding claim 24, note a tie layer or an adhesive disposed between two adjacent layers of the at least two film layers (see col. 5, lines 18-19). Regarding claim 25, note a barrier layer against mineral oils disposed between two adjacent layers of the at least two film layers (see col. 6, lines 59-64). Regarding claim 26, the barrier layer comprises a layer of lacquer (see col. 6, lines 60-64). Regarding claim 27, note at least two film layers comprise a first film layer (Fig. 2, #22) and a second film layer (Fig. 2, #22A), the first film layer (Fig. 2, #22) being located further away from the bituminous layer (Fig. 2, #12) and inherently having a larger coefficient of elongation than the second film layer since both films are made from different materials (see col. 6, lines 6-12). Regarding claim 28, the bituminous layer (Fig. 3, #12)

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has a surface facing away from the at least two film layers (Fig. 3, #22 and #22A) and a release liner is provided on the surface (Fig. 3, #40). Regarding claims 29 and 30, the release liner is siliconized paper (see col. 3, lines 1-2).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over either Stierli (US 4,442,148) or Jenkins et al. (US 5,824,401) or Wiercinski et al. (US 5,687,517) in view of Gurtler (US 3,686,060).

Stierli, Jenkins and Wiercinski each disclose the film-bitumen combination as shown above. However, each fails to disclose at least one edge of part of the at least two film layers projects beyond the bituminous layer. Gurtler teaches that it is old and well-known in the analogous art to have a plastic film layer (Fig. 1, numeral 3) project beyond the bituminous layer (Fig. 1, numeral 4) for the purpose of preventing unintentional contact with the bitumen layer during processing of the laminated sheet into a wrapping. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicants invention was made to modify at least one edge of part of the at least two film layers in either Stierli, Jenkins or Wiercinski to project

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beyond the bituminous layer as suggested by Gurtler in order to prevent unintentional contact with the bitumen layer during processing of the laminated sheet into a wrapping.

10. **Claims 13 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over either Stierli (US 4,442,148) or Jenkins et al. (US 5,824,401) or Wiercinski et al. (US 5,687,517) in view of Zickell et al. (US 4,992,315).

Stierli, Jenkins and Wiercinski each disclose the film-bitumen combination as shown above. However, each fails to disclose at least one edge of part of the at least two film layers is shorter than the bituminous layer. Zickell et al. teaches that it is old and well-known in the analogous art to have at least one edge of part of a plastic film layer (Fig. 3, #28) being shorter than the bitumen layer (Fig. 3, #14) for the purpose of providing a leading edge portion to act as a starter strip for receiving thereon the first row of roofing shingles. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified at least one edge of part of the at least two plastic film layers in either Stierli, Jenkins or Wiercinski et al. to be shorter than the bituminous layer as suggested by Zickell et al. in order to provide a leading edge portion to act as a starter strip for receiving thereon the first row of roofing shingles.

11. **Claims 17 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiercinski et al. (US 5,687,517) in view of Zickell et al. (US 4,992,315).

Wiercinski et al. discloses the film-bitumen combination as shown above. However, Wiercinski et al. fails to disclose the non-slip coating and the embossing being shorter at least along one edge of the combination. Zickell et al. teaches that it is old and well-known in the art to have an embossed non-slip film (Fig. 3, #28) being shorter along at least one edge of a film-

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bitumen combination for the purpose of providing a small portion having slip resistance where one can stand to reduce the risk of falling (see col. 4, lines 63-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the non-slip coating and embossing in Wiercinski et al. to be shorter at least along one edge of the combination as suggested by Zickell et al. in order to provide only a portion that is slip resistant where one can stand to reduce the risk of falling.

12. **Claim 31** is rejected under 35 U.S.C. 103(a) as being unpatentable over Stierli (US 4,442,148) or Wiercinski et al. (US 5,687,517) in view of Kalkanoglu (US 4,757,652).

Stierli and Wiercinski et al. each disclose the film-bitumen combination as shown above. However, each fails to disclose the release liner having several sections. Kalkanoglu teaches that it is old and well-known in the analogous art to have a release liner with several sections for the purpose of allowing the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck (see col. 1, lines 5-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the release liner in either Stierli or Wiercinski et al. to have several sections as suggested by Kalkanoglu in order to allow the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck.

Response to Arguments

13. Applicant's arguments filed 6/10/05 have been fully considered but they are not persuasive. Applicant argues that "Stierli describes a single plastic film layer, which is used to protect a bituminous sheet. Between the plastic film layer and the bituminous sheet a barrier

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layer is arranged. This arrangement differs also from Applicant's invention as recited in amended claim 1, which uses at least two plastic film layers of different materials." However, it is to be pointed out that Stierli clearly discloses two plastic film layers of different materials (Fig. 1, #2 and #3 and see col. 3, lines 66-68 and col. 4, lines 9-11). Therefore, Stierli clearly teaches the film-bitumen combination as presently claimed in the present invention.

Applicant further argues that "Jenkins describes a double plastic layer construction, which is protected against oily substances of a bituminous layer by a barrier layer. In contrast to Applicant's invention as recited in claim 1 as amended, the two plastic layers in Jenkins are not made of different material. Although one layer in Jenkins contains light absorbing carbon black and the other layer contains a light reflective pigment, nevertheless Jenkins' films are made of the same material." However, it is to be pointed out that Jenkins clearly teaches two plastic film layers made from different materials (see col. 4, lines 8-10 and lines 62-64). Therefore, Jenkins clearly teaches the film-bitumen combination as presently claimed in the present invention.

Applicant also argues that Wiercinski et al. describes a combination of a multilayer film construction, which is made of two symmetric film combinations of three film layers, which it is respectfully submitted differs completely from Applicant's invention as recited in amended claim 1." However, it is to be pointed out that Wiercinski et al. clearly teaches two plastic film layers made from different materials (see col. 6, lines 7-12 and lines 62-64). Therefore, Wiercinski et al. clearly teaches the film-bitumen combination as presently claimed in the present invention.

Applicant further argues that "Zickell et al. discloses a roofing membrane and method having a reinforcing mat sandwiched between top and bottom layers of a tacky polymer-

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modified bitumen. Although Zickell et al. shows, in Fig. 3, a covering film 28 that does not cover the bituminous layer 14 completely, there is no disclosure or suggestion of the specific combination recited in Applicant's claims 17 and 19 in which a film-bitumen combination includes at least three layers with at least two film layers being made from different materials and the film layers are produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET) or polyacrylonitrile. Moreover, there is no disclosure or suggestion in Zickell et al. of not covering the bituminous layer completely in combination with extending the film construction over the bituminous layer at least at one edge." However, it is to be pointed out that Wiercinski et al. clearly teaches a film-bitumen combination including at least three layers (Figure 2) with at least two film layers made from different materials (Fig. 2, #22 and #22A and see col. 6, lines 58-64) and the film layers are produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET) or polyacrylonitrile (see col. 4, lines 31-36 and col. 6, lines 7-10 and lines 62-64). Zickell et al. was merely cited for suggesting that it is old and well-known in the art to have an embossed non-slip film being shorter along at least one edge of a film-bitumen combination for the purpose of providing a small portion having slip resistance where one can stand to reduce the risk of falling. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the embossed non-slip coating in Wiercinski et al. to be shorter than the bitumen layer at least along one edge of the film-bitumen combination as suggested by Zickell et al. in order to provide only a portion that is slip resistant where one can stand to reduce the risk of falling. One skilled in the art would clearly be able to modify the embossed non-slip coating in Wiercinski et al. to be

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shorter than the bitumen layer at least along one edge of the combination, if so desired. Thus, the claims fail to patentably define over the prior art as applied above.

Furthermore, Applicant argues that “Kalkanoglu discloses a roofing product that has a release film on the back surface thereof which is split to allow the material to be flopped back with one side being stuck and the other side flopped down. However, there is no disclosure or suggestion of Applicant’s film-bitumen combination with at least three layers wherein at least two film layers are made from different materials and the film layers are produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET) or polyacrylonitrile.” However, as pointed out above, Stierli and Wiercinski et al. each clearly teach the film-bitumen combination including at least three layers with at least two film layers made from different materials and the film layers are produced from a polyolefin, polypropylene, polyamide, polyethylene terephthalate (PET) or polyacrylonitrile. Kalkanoglu was merely cited for suggesting that it is old and well-known in the art to have a release liner with several sections for the purpose of allowing the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck (see col. 1, lines 5-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have modified the release liner in either Stierli or Wiercinski et al. to have several sections as suggested by Kalkanoglu in order to allow the material to be flopped back, so that one side can be stuck, and then the other side can be flopped down and stuck. One skilled in the art would clearly be able to modify the release liner in either Stierli or Wiercinski et al. to have several sections, if so desired. Thus, the claims fail to patentably define over the prior art as applied above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CAS

Catherine A. Simone
Examiner
Art Unit 1772
August 9, 2005

[Signature]
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

8/15/05